

Remarks

Claims 1-21 were pending in the application. Claims 1-3, 5-14, 16-19, and 21 were rejected. Claims 4, 15, and 20 were objected to. Claims 1, 2, 10-12, and 18 are canceled without prejudice to or disclaimer of the recited subject matter. Claims 3-6, 8, 13-17, and 19-21 are amended. Claims 3-9, 13-17, and 19-21 are now pending. Claims 4, 15, and 20 are the independent claims. Reconsideration of the amended application is respectfully requested.

The examiner rejected claims 1-9 and 11-16 as reciting non-statutory subject matter, citing the Federal Circuit's decision in *In re Bilski*. In particular, the examiner relied on language from *Bilski* to assert that a statutory process under 35 USC 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This interpretation of the requirement for patentable processes under 35 USC 101 has since been overturned by the Supreme Court. *Bilski et al. v. Kappos*, 561 U.S. ____ (2010). From the Syllabus of the slip opinion at pages 2-3:

The machine-or-transformation test is not the sole test for patent eligibility under §101. The Court's precedents establish that although that test may be a useful and important clue or investigative tool, it is not the sole test for deciding whether an invention is a patent-eligible "process" under §101. In holding to the contrary, the Federal Circuit violated two principles of statutory interpretation: Courts " 'should not read into the patent laws limitations and conditions which the legislature has not expressed.' " *Diamond v. Diehr*, 450 U. S. 175, 182, and, "[u]nless otherwise defined, 'words will be interpreted as taking their ordinary, contemporary, common meaning,' " *ibid*. The Court is unaware of any ordinary, contemporary, common meaning of "process" that would require it to be tied to a machine or the transformation of an article. Respondent Patent Director urges the Court to read §101's other three patentable categories as confining "process" to a machine or transformation. However, the doctrine of *noscitur a sociis* is inapplicable here, for §100(b) already explicitly defines "process," see *Burgess v. United States*, 553 U. S. 124, 130, and nothing about the section's inclusion of those other categories suggests that a "process" must be tied to one of them.

Finally, the Federal Circuit incorrectly concluded that this Court has endorsed the machine-or-transformation test as the exclusive test. Recent authorities show that the test was never intended to be exhaustive or exclusive. See, e.g., *Parker v. Flook*, 437 U.S. 584, 588, n. 9. Pp. 5–8.

and from the opinion at pages 4-5:

Section 101 thus specifies four independent categories of inventions or discoveries that are eligible for protection: processes, machines, manufactures, and compositions of matter. “In choosing such expansive terms . . . modified by the comprehensive ‘any,’ Congress plainly contemplated that the patent laws would be given wide scope.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980). Congress took this permissive approach to patent eligibility to ensure that “‘ingenuity should receive a liberal encouragement.’” *Id.* at 308–309 (quoting 5 Writings of Thomas Jefferson 75–76 (H. Washington ed. 1871)).

The Court’s precedents provide three specific exceptions to §101’s broad patent-eligibility principles: “laws of nature, physical phenomena, and abstract ideas.” *Chakrabarty*, *supra*, at 309. While these exceptions are not required by the statutory text, they are consistent with the notion that a patentable process must be “new and useful.” And, in any case, these exceptions have defined the reach of the statute as a matter of statutory *stare decisis* going back 150 years. See *Le Roy v. Tatham*, 14 How. 156, 174– 175 (1853). The concepts covered by these exceptions are “part of the storehouse of knowledge of all men . . . free to all men and reserved exclusively to none.” *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948).

The §101 patent-eligibility inquiry is only a threshold test. Even if an invention qualifies as a process, machine, manufacture, or composition of matter, in order to receive the Patent Act’s protection the claimed invention must also satisfy “the conditions and requirements of this title.” §101. Those requirements include that the invention be novel, see §102, nonobvious, see §103, and fully and particularly described, see §112.

It is respectfully submitted that claims 1-9 and 11-16 recite a statutory process as defined in 35 USC 100(b) that is not a law of nature, physical phenomenon, or abstract idea. As such, the claims pass the threshold test of statutory subject matter and need not be tied to a particular machine or provide a particular transformation, and the rejection should therefore be withdrawn.

The examiner rejected claims 10 and 11 as reciting non-statutory subject matter, asserting that the claimed subject matter is a mere compilation of data. Claims 10 and 11 are canceled.

The examiner rejected claim 17 as reciting non-statutory subject matter, asserting that the claimed subject matter is means embodying functional descriptive material, and further that the written description does not provide examples of the claimed means that are not transitory propagating signals. Claim 17 is amended to recite a computer-readable "medium" that is non-transitory. Thus, the functionally-descriptive material is structurally and functionally interrelated to the medium, and explicitly excludes transitory, propagating signals, and is therefore statutory. The rejection, therefore, should be withdrawn.

The examiner rejected claims 1, 2, 5-7, 10-14, 16-19, and 21 as being unpatentable over Kodama et al., and claims 3, 8, and 9 as being unpatentable over Kodama et al., in view of Murakami. The examiner also objected to claims 4, 15, and 20 as depending from a rejected base claim, but acknowledged that these claims would be allowable if rewritten in independent form, including all of the features of the base claim and any intervening claims.

Claim 4 is amended into independent form, including all features of base claim 1 and intervening claim 2, which are canceled. Claims 3, 5, 6, 8, 13, and 19 are amended to depend from independent claim 4. Claims 7 and 9 depend from claims 6 and 8, respectively. Claims 3-9, 13, and 19 are therefore allowable, and the objection to or rejection of these claims should be withdrawn.

Claim 15 is amended into independent form, including all features of base claim 12, which is canceled. Claims 14, 16, and 17 are amended to depend from independent claim 15. Claims 14-17 are therefore allowable, and the objection to or rejection of these claims should be withdrawn.

Claim 20 is amended into independent form, including all features of base claim 18, which is canceled. Claim 21 is amended to depend from independent claim 20. Claims 20 and 21 are therefore allowable, and the objection to or rejection of these claims should be withdrawn.

It is submitted that all objections and rejections have been overcome. It is therefore requested that the Amendment be entered, the claims allowed, and the case passed to issue. If any unresolved issues remain, the examiner is encouraged to contact the undersigned by telephone to expedite resolution.

Respectfully submitted,



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Date

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